

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE** FAX RECEIVED

AUG 17 2006

OFFICE OF PETITIONS

In re Application of:  
William J. WELSH *et al.*

Group Art Unit: 1625

Serial No.: 10/665,377

Examiner: D.M. Seaman

Filed: September 18, 2003

Atty. Dkt. No.: UVMO:021US

For: OPIATE ANALOGS SELECTIVE FOR  
THE  $\delta$ - OPIOID RECEPTOR

CERTIFICATE OF FACSIMILE TRANSMISSION 37 C.F.R. § 1.8	
I hereby certify that this correspondence is being faxed to: Mail Stop Petition; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 facsimile number (571) 273-0025 on the date below:	
August 17, 2006 Date	Steve L. Highlander

**PETITION UNDER 37 C.F.R. § 1.313(c)(2)****Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

This is a petition to withdraw U.S. Serial No. 10/665,377 from issue under 37 C.F.R. § 1.313(c)(2) in consideration of a request for continued examination in compliance with 37 C.F.R. § 1.114. This petition is necessitated because a supplemental European Search Report for the EP counterpart of this case identified Gao, Peng et al., *J. Med. Chem.* 1998, 41, 3091-3098 as an allegedly anticipatory reference. This reference is contained in the IDS which is

attached to this petition.

08/21/2006 CKHLOK 00000001 501212 10665377

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Attached as Appendixes A-E are:

Appendix A: Supplemental Information Disclosure Statement

Appendix B: PTO Form 1449

Appendix C: Supplementary European Search Report


Appendix D: Gao, Peng et al., *J. Med. Chem.* 1998, 41, 3091-3098

Appendix E: Request for Continued Examination

The fee for the petition as set forth in § 1.17(h) is \$130. The Commissioner is hereby authorized to charge this fee and any fees which are believed to be due in connection with this filing under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski Deposit Account No.: 50-1212/UVMO:021US/SLH.

Should the examiner have any questions regarding this petition, a telephone call to the undersigned is invited.

Respectfully submitted,

  
Steven L. Highlander  
Reg. No. 37,642  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

Date: August 17, 2006

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OFFICE OF PETITIONS

## FACSIMILE TRANSMISSION

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PTO/SB/21 (09-04) MODIFIED

<b>TRANSMITTAL FORM</b>	<b>Application Number:</b>	10/665,377	<b>FAX RECEIVED</b>  AUG 17 2006  <b>OFFICE OF PETITIONS</b>
	<b>Filing Date:</b>	September 18, 2003	
	<b>First Named Inventor:</b>	William J. Welsh	
	<b>Art Unit:</b>	1625	
	<b>Examiner Name:</b>	D.M. Seaman	
<b>Total Number of Pages in this Submission :</b> 23		<b>Attorney Docket Number:</b> UVMO:021US	

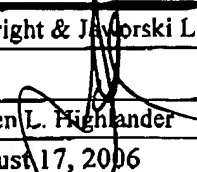
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**Remarks:**

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/UVMO:021US/MHV

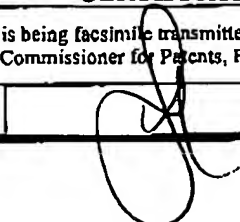
**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

<b>Firm Name</b>	Fulbright & Jaworski L.L.P.	<b>Customer Number</b>	32425
<b>Signature</b>			
<b>Printed Name</b>	Steven L. Highlander	<b>Reg. No.</b>	37,642
<b>Date</b>	August 17, 2006		

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

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## APPENDIX A